

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 100051.11211 (WAL_SCO.007)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number  10/611533		Filed  June 30, 2003
	First Named Inventor  Scott A. Waldman		
	Art Unit  1642		Examiner  Misook Yu
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.   This request is being filed with a notice of appeal.   The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.   I am the <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <input type="checkbox"/> applicant/inventor.   <input type="checkbox"/> assignee of record of the entire interest.            See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.            (Form PTO/SB/96)   <input checked="" type="checkbox"/> attorney or agent of record.            Registration number <u>52,201</u>.   <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.            Registration number if acting under 37 CFR 1.34 _____         </div> <div style="width: 45%;"> <u>Daniel M. Scolnick, Reg. No. 52,201</u>            _____            Signature  <u>Daniel M. Scolnick</u>            _____            Typed or printed name  <u>610.640.7820</u>            _____            Telephone number  <u>November 12, 2009</u>            _____            Date         </div> </div>			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

**DOCKET NO. 100051.11211  
PATENT**

**SERIAL NO. 10/611,533  
FILED: June 30, 2003**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re application of:** Scott A. Waldman *et al.*      **Confirmation No:** 4518

**Serial No.:** 10/611,533      **Group Art Unit:** 1642

**Filed:** June 30, 2003      **Examiner:** Misook Yu

**Title:**      **COMPOSITIONS AND METHODS FOR IDENTIFYING AND  
TARGETING CANCER CELLS OF ALIMENTARY CANAL ORIGIN**

*VIA EFS WEB*

**Mail Stop: AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Dear Sir:**

This response is being filed in response to the outstanding Final Official Action dated May 12, 2009 and the Advisory Action, dated August 27, 2009 in connection with the above-identified patent application. Applicants enclose herewith a Pre-Appeal Brief Request for Review, a Notice of Appeal, a petition for extension of time and payment of the appropriate fee. In response to the Final Rejection and the Advisory Action, Applicants respectfully request reconsideration of the pending rejections in view of Applicants Supplemental Response filed September 14, 2009 and the present request herein. Applicants respectfully request entry of the

**DOCKET NO. 100051.11211**  
**PATENT**

**SERIAL NO. 10/611,533**  
**FILED: June 30, 2003**

amendments filed on September 14, 2009 and withdrawal of the pending rejections upon reconsideration.

#### **REMARKS**

Applicants filed a Supplemental response on September 14, 2009 in view of the Advisory Action mailed August 27, 2009. The supplemental response amended the claims to recite that the methods claimed therein “consist of” of the recited step. Upon entry of the amendment, claims 29-31, 39 and 46-54 are in allowable condition. As of November 12, 2009 the Office has not yet responded to the supplemental response. Accordingly, Applicants have submitted the present pre-appeal brief conference request in view of the statutory six month deadline.

#### ***Claim Rejection Under 35 U.S.C. § 103***

Claims 29-31, 39, 47-51, 53 and 54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Silberg in view of US Patent No. 5,601,990 or over Silberg in view of US Patent No. 5,601,990 and further in view of Genbank Accession no. U51095.

The Office asserted that because “Silberg teaches the ‘possibility’ of CDX1 being a marker” and the open term of “comprising” does not exclude other steps or tests for diagnosis in addition to CDX1” the subject matter of claims 29-31, 39, 47-51, 53 and 54 are obvious. The pending claims recite the more restricted phrase “consisting of.” The combination of the references fail to render the presently claimed invention obvious. Accordingly, as amended to the rejection is obviated.

Applicants respectfully request that the rejections of claims 29-31, 39, 47-51, 53 and 54 be withdrawn.

#### ***Withdrawal of Claims***

Claims 46 and 52 have been withdrawn. No reason is provided for the withdrawal of the claims but it is presumed that in view of the earlier amendment, claims 46 and 52 are redundant..

**DOCKET NO. 100051.11211**  
**PATENT**

**SERIAL NO. 10/611,533**  
**FILED: June 30, 2003**

Applicants respectfully note that upon entry of the amendment of claims 29 and 49, claims 46 and 52 will differ in scope from each of claims 1-3, 8-13, 19, 20, 55-57, 60 and 61. Accordingly, reconsideration is proper and hereby requested.

***Conclusion***

Claims 1-3, 8-13, 19, 20, 29-31, 39, 46-57, 60 and 61 are in condition for allowance. A notice of allowance is earnestly solicited. Applicants invite the Examiner to contact the undersigned at 610.640.7820 to clarify any unresolved issues raised by this response.

The Commissioner is hereby authorized to charge any deficiencies of fees and credit of any overpayments to Deposit Account No. 50-0436.

Respectfully submitted,

/Daniel M. Scolnick, 52,201/  
Daniel M. Scolnick, Ph.D.  
Registration No. 52, 201

Dated: November 12, 2009  
PEPPER HAMILTON, LLP  
400 Berwyn Park  
899 Cassatt Road  
Berwyn, PA 19312-1183  
Telephone: 610-640-7820  
Facsimile: 610-640-7835